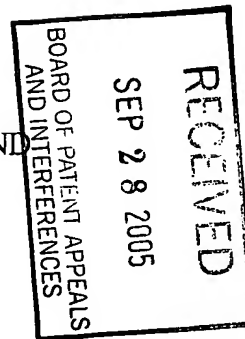




P-3976-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: ALEXANDER M.L. KELLER
FOR: INJECTION MOLDED ARTIFICIAL FINGERNAILS AND
PACKAGING THEREOF
SERIAL NO.: 10/635,129
FILED: August 7, 2003
EXAMINER: John J. Wilson, Primary Examiner, Art Unit 3732



NOTICE OF APPEAL
AND
APPELLANT'S BRIEF

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

Sir

NOTICE OF APPEAL

Appellant appeals the Final Rejection of attached of 07/25/2005 and herewith
submits the fees of \$500.

APPELLANT'S BRIEF

CONTENT AND FORMAT OF THE APPEAL BRIEF (\$41.37)

1. Real Party in Interest

The party named in the caption.

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01 FC:2401 250.00 OP
02 FC:2402 250.00 OP



2. **Related Appeals or Interferences**

None.

3. **Status of Claims**

A. Status

Claim 1 (currently amended)

B. Identification of the appealed claim(s)

Claim 1

4. **Status of Amendments Filed Subsequent to Final Rejection**

None

5. **Summary of Claimed Subject Matter**

- A. A concise explanation of subject matter in each independent claim referring to specification by page and line number.

Lines

Specification Page 4

4 Underlying the present invention is the recognition that in injection molding of the
5 artificial fingernails 10 a correlation can be advantageously attained between the artificial
6 fingernails thusly molded and the size and shape variation occurring in the growth of natural
7 fingernails. As best understood from Figs. 1 and 2, the injection molding process produces a so-
8 called tree, generally designated 22, consisting of a sprue 24 having at spaced locations along the
9 sprue 24 connected, as at 26, to progressively sized machined cavities producing from said cavities
10 correspondingly progressively varying shaped and sized work-in-process artificial fingernails 10A.
11 The shape-molding plastic of choice is PVC of pallet designation M48-10 commercially available

12 from PolyOne of Knottingham, Pennsylvania, it having been found in practice that the resulting
13 work-in-process artificial fingernails 10A closely retain the shape and size of machined cavities in a
14 steel molding die and exhibit a desirable minimum extent of mold shrinkage while manifesting
15 maximum clarity in appearance, whether molded to be clear or in a selected color of an additive.

16 As best understood from Fig. 2, a select number of artificial fingernails 10 detached
17 from the tree 22 are placed in tray compartments 28 correlated to a size chart 30 in the lid 32 of a
18 box container 34 of the product.

Lines

Specification Page 5

1 In a preferred embodiment in providing bulk quantities of artificial fingernails 10A
2 for use at beauty salons or for packaging at fulfillment houses for mail order and TV-solicited sales,
3 box 34 has two rows of five compartments 28 per row which are correlated by eye to a similar
4 arrangement of the size designations on the chart 30.

B. 1. Every means plus function identified.

None

2. Step plus function identified.

None

3. The structure, material, or acts referring to the specification by page and
line number of what is identified in B.1 and B.2.

Not Applicable

6. Grounds of Rejection To Be Reviewed On Appeal.

1. That claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over LaToie et al. (5450864) in view of Park (d4451192) and Prusser (5251751).

7. Argument

- A. For ground of rejection 1.

It is not without intending to have a bearing on the issue on appeal that the examiner cites as the primary reference the '864 patent followed by the '192 and '751 patents, but quite the contrary. This sequence enables the examiner to argue the alleged pertinence of the '864 patent which is concerned with the injection molding of artificial fingernails, whereas the invention being claimed is not injection molding but the packaging of artificial fingernails as clearly stated in the claim preamble and followed by claim subsets A and B. Completing the steps of subsets A and B are not ministerial, as the examiner would presumably have us believe, but provide a necessary preparation for the packaging method of the claim.

The packaging method then proceeds with the next significant step, after the injection molding, as said step is expressed in subset D namely that of detaching the molded artificial fingernails from the sprue (used as a work-in-process method expedient) which provides "graduated sizes [of the detached molded artificial fingernails] between [the] largest and smallest sizes."

The final method step, namely subset E, consists of "placing [the detached artificial fingernails maintained in their graduated sizes] in said size-designated

compartments...according to said locations thereof as removed from said sprue” (underlining added).

The whereby clause of the claim expresses the advantageous use of the graduated sizes of the molding process of producing the artificial fingernails obviating the tedium of manually sorting the molded artificial fingernails according to size.

The pertinency of the injection molding ‘864 patent is, at best, relevant only to claim subset C, and even as to this extent it is questionable because the sprue with attached fingernails is not in the ‘864 patent disclosed as a work-in-process expedient to a packaging method. The ‘864 patent discloses an injection molding production process resulting in a sprue with attached artificial fingernails which by common experience are detached from the sprue, and which further as known by common experience are most likely commingled, thus rendering the graduated sizes of the detached artificial fingernails of nil consequence.

Having sequenced the rejection starting with the injection molding ‘864 patent the examiner, in effect, is arguing that disregarding the commingling prior art practice of handling molded objects to the claimed practice of maintaining the graduated sizes thereof is an obvious departure. However, the test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1980). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior

art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Copr., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

On this record, the examiner has not made out a prima facie case of obviousness.

8. **Claims Appendix**

A copy of the claim(s) involved in the appeal is annexed as an exhibit hereto.

9. **Evidence Appendix**

Copies of any evidence entered and relied upon in the appeal.

None

10. **Related Proceedings Appendix**

Copies of decisions rendered by a court or the Board in any proceeding identified in the related appeals and interferences section.

None

For the foregoing reasons, the rejection under 35 U.S.C. 103(a) should be overruled.

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Dated: 9/26/05

Trademarks3976-1.NOA & BRIEF

CLAIM APPENDIX

1. A method of packaging artificial fingernails according to graduated sizes correlated to sizes of natural fingernails comprising the steps of:
 - A. packaging said artificial fingernails in a rectangular box-like container having a bottom delineated into ten compartments in two parallel rows of five compartments in each row and having a hinged lid thereon;
 - B. positioning for display in an open condition of said lid a chart imprinted with numerical size designations correlated by corresponding two rows of five imprinted locations in each row to said compartments of said bottom;
 - C. molding in an injection molding machine to produce as a work-in-process a molded tree of polyvinyl chloride construction material characterized in
 - (1) having in said molded tree a sprue;
 - (2) having in attached adjacent spaced relation along said sprue ten work-in-process artificial fingernails of five in number on one side of said sprue and five in number on the other side of said sprue; and
 - (3) graduated sizes of said ten work-in-process artificial fingernails as determined by said spaced relation along said sprue being of the largest size at a center location on said sprue and the smallest size at a location on an end of said sprue and in graduated sizes therebetween;
 - D. detaching said work-in-process artificial fingernails from said sprue of said tree from said sprue center location said work-in-process artificial fingernails of said largest size, from said sprue end locations said work-in-process artificial

fingernails of said smallest size, and from said remaining sprue locations between said center and end locations said work-in-process artificial fingernails of graduated sizes between said largest and smallest sizes; and

- E. placing in said size-designated compartments said detached artificial fingernails according to said locations thereof as removed from said sprue;

whereby the sizing of said packaged artificial fingernails is facilitated without the tedium of having to be measured.